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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/502,527	11/17/2004	Wolfram Andersch	CS-8286/LeA 35,814	7485
34469	7590	09/27/2005	EXAMINER	
BAYER CROPSCIENCE LP Patent Department 100 BAYER ROAD PITTSBURGH, PA 15205-9741			QAZI, SABIHA NAIM	
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/502,527	ANDERSCH ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Sabiha Qazi	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 17 November 2004.  
2a)  This action is **FINAL**.                    2b)  This action is non-final.  
3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 9-16 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 9-16 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All   b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_ .

**Non-Final Office Action**

Claims 9-16 are pending. No claim is allowed. Preliminary amendments are entered.

***Information Disclosure Statement***

The information disclosure statement filed on 4/15/04 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

1. Two pages of IDS filed on 4/15/05 does not contain list of references.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 9, 13 and 14 rejected under 35 U.S.C. 102(b) as being anticipated by ASRAR et al., US PATENT 6,838,473. The reference discloses a method of preventing damage to the

seeds and/or shoots and foliage of a plant by a pest includes treating the seed from the plant with a composition of synergistic combination of clothianidin and at least one pyrethroid or one pyrethrin. See lines 1-41 in col. 4; lines 40-67 in col. 5; Table 1 in col. 7; lines 1-67 in col. 6, especially line 22 where beta cyfluthrin and line 38, where lambda cyhalothrin are disclosed. See also lines 34-45, where synergistic combination is disclosed. The composition as claimed is considered anticipated by the reference.

It had been held by the courts that even in a case where the reference does not teach the same use of the composition, the two different intended uses are not distinguishable in terms of the composition, see *In re Thuau*, 57 USPQ 324; *Ex parte Douros*, 163 USPQ 667; and *In re Craigie*, 89 USPQ 393.

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 9-16 rejected under 35 U.S.C. 103(a) as being unpatentable over ASRAR et al., US PATENT 6,838,473 and EP 1,149,532 A1. These reference teach a composition which embraces Applicant's claimed invention. See the entire documents.

US '473 teaches a method of preventing damage to the seeds and/or shoots and foliage of a plant by a pest includes treating the seed from the plant with a composition of synergistic combination of clothianidin and at least one pyrethroid or one pyrethrin. See lines 1-41 in col. 4; lines 40-67 in col. 5; Table 1 in col. 7; lines 1-67 in col. 6, especially line 22 where beta cyfluthrin and line 38, where lambda cyhalothrin are disclosed. See also lines 34-45, where synergistic combination is disclosed.

EP '532 teaches a method of controlling the flies by a composition containing the compounds having an affinity of nicotinic acetylcholine receptor of insect. The most preferred compound is clothianidin (the same compound as formula (I) in claim 1 is presently claimed). The reference further teaches that various insecticides, miticides (acricides) and fungicides may be added to this composition. The compounds include cyhalothrin, avermectin, emamectin, and

emamectin-benzoate (see lines 2 and 5 on page 7). See section [0017] on page 5; section [0029]-[0033] on page 6 and section [0035] and [0036] on page 7

Instant claims are selection of the prior art composition, prior art compositions are broader than presently claimed composition.

It would have been obvious to one skilled in the art to prepare additional beneficial composition for the controlling pests because prior art teaches the same composition. It had been held by the courts that even in a case where the reference does not teach the same use of the composition, the two different intended uses are not distinguishable in terms of the composition, see *In re Thuau*, 57 USPQ 324; *Ex parte Douros*, 163 USPQ 667; and *In re Craige*, 89 USPQ 393. Since prior art also teach the synergistic combination of clothianidin and other compounds as presently claimed one skilled in the art would be motivated to prepare such compositions. No criticality of invention was found and no unexpected result was noted.

In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha Qazi whose telephone number is (571) 272-0622. The examiner can normally be reached on any business day.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on (571) 272-0887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Friday, September 16, 2005

  
SABIHA QAZI, PH.D  
PRIMARY EXAMINER